

## **REMARKS**

In response to the above-identified Office Action, Applicants amend the claims and seek reconsideration thereof in view of the following remarks. Applicants amend claims 1, 9, 17 and 19. Applicants cancel claims 6 and 24. Applicants add new claims 27-31. Accordingly, claims 1-5, 7-23 and 25-31 are pending in the application.

### **I. Claims Rejected Under 35 U.S.C. § 102**

Claims 1-5, 9-12 and 19-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. US2002/007493 by Laura J. Butler, et al. (hereinafter "Butler").

To anticipate a claim, the Examiner must show that a single reference teaches each of the elements of a claim. In regard to claim 1, this claim, as amended, includes the elements of "removing background content from the data content to create a transparent space in the data content" and "overlaying the data content onto the video content to generate combined content in a single window, such that the video content is visible through the transparent space." The Examiner admits in paragraph 5 on page 4 of the Office Action that Butler does not teach these elements of claim 6. The Examiner relies on U.S. Patent No. 5,712, 994 issued to Jefferson (hereinafter "Jefferson") for curing these defects of Butler in rejecting dependent claim 6 under 35 U.S.C. § 103. Applicants have reviewed the cited section of Jefferson, namely, Figure 6 and col. 5, but have been unable to discern any part therein that teaches removing background material from data content in order to create a transparent space. Rather, the cited section of Jefferson appears to teach placing an already transparent overlay window over a graphic element. See col. 5, lines 55-65.

Further, Butler teaches a color key system where video content is combined with overlay content by overwriting a designated colored background within the video content such that the video content replaces the designated colored background and leaves the other data untouched to create the overlay. Thus, the Examiner's proposed combination of Jefferson and Butler is inappropriate, as it would alter the principle of operation for the primary reference Butler by deviating from the color key system of Butler. See MPEP § 2143.01 including the subsection

titled "The Proposed Modification Cannot Change the Principle of Operation of a Reference."

Thus, the Examiner has not established that claim 1 is anticipated by Butler or that Butler can be properly combined with Jefferson to render claim 1 obvious. Accordingly, reconsideration and withdrawal of the rejection of claim 1 are requested.

In regard to claims 2-5, these claims depend from independent claim 1 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 1, these claims are not anticipated by Butler. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 2-5 are requested.

In regard to claim 9, this claim includes the elements of a "storage memory that includes low-bandwidth media, the low-bandwidth media prepared by the remote server by removing high bandwidth content." Applicants have reviewed the cited sections of Butler but have been unable to determine any part therein that teaches preparing low-bandwidth media by removing high-bandwidth elements where the remote server updates a low bandwidth media through the network. Thus, Applicants believe claim 9, as amended, includes elements that are not taught by Butler. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 9 are requested.

In regard to claims 10-12, these claims depend from independent claim 9 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 9, these claims are not anticipated by Butler. Accordingly, reconsideration and withdrawal of the anticipation rejections are requested.

In regard to claim 19, this claim has been amended to include on many of the same elements as independent claim 1. Namely, claim 19 includes the elements of "removing background content from the data content to create a transparent space in the data content." Thus, at least for the reasons mentioned above in regard to independent claim 1, Butler does not teach each of the elements of claim 19. Accordingly, reconsideration and withdrawal of the anticipation rejection of claim 19 are requested.

In regard to claims 20-23, these claims depend from independent claim 19 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent

claim 19, these claims are not anticipated by Butler. Accordingly, reconsideration and withdrawal of the anticipation rejection of claims 20-23 are requested.

## **II. Claims Rejected Under 35 U.S.C. § 103**

Claims 7 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Butler. Applicants respectfully disagree for the following reasons.

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited reference teaches or suggests each of the elements of the claims. In regard to claims 7 and 25, these claims include the elements of "uploading system data periodically from the at least one device." The Examiner admits that Butler does not teach these elements of claims 7 and 25. See page 4 of the Office Action. Rather, the Examiner relies on Official Notice to teaching these elements. Applicants respectfully traverse this reliance on Official Notice. Applicants believe that the Examiner has failed to read the language of the claims as a whole. Claims 7 and 25 claim uploading system data periodically from the at least one device, this device being a device that integrates markup language content with video content. Applicants respectfully request that the Examiner provide support for his assertion that it is well known to upload system data from such a device. Further, the Examiner has failed to provide a motivation for modifying Butler to include these elements. See MPEP § 2143.01 section subtitled "The Prior Art Must Suggest the Desirability of the Claimed Invention." Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 7 and 25 over Butler. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 7 and 25 are requested.

Claims 6, 8, 24 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Butler in view of U.S. Patent No. 5,712,994 issued to Jefferson, et al. (hereinafter "Jefferson."). Applicants respectfully disagree for the following reasons. In regard to claims 6 and 24, these claims have been cancelled.

In regard to claims 8 and 26, these claims depend from independent claims 7 and 25 and incorporate the limitations thereof. Specifically, these claims include the elements of uploading system data periodically from the at least one device. As set forth above, Butler does not teach or suggest these elements of claims 8 and 26. Further, Jefferson does not cure these defects of Butler. The Examiner has not indicated and Applicants have been unable to discern any part of Jefferson that teaches or suggests these elements of claims 8 and 26. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness for claims 8 and 26. Accordingly, reconsideration and withdrawal of the obviousness rejection of claims 8 and 26 are requested.

Claims 13-17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Butler in view of U.S. Patent No. 6,401,202 issued to Abgrall (hereinafter "Abgrall") and U.S. Patent No. 5,557,317 issued to Nishio (hereinafter Nishio). Applicants respectfully disagree for the following reasons.

In regard to claim 13, this claim includes the elements of a local directory structure "wherein each directory is associated with a device, the server to transmit at least one file from the at least one directory to the associated at least one device." The Examiner admits that Butler "fails to disclose a server having a local directory structure, wherein each directory is associated with the device." Page 5 of the Office Action. The Examiner has goes on to argue that Abgrall, col. 9, lines 44-68 teaches each of these elements of claim 13. However, Applicants have reviewed the cited section and the arguments of the Examiner that have been unable to discern any part in Abgrall that teaches a local directory structure where each directory is associated with a device. Applicants have found no mention of such a structure and association for a directory.

Further, Applicants believe that the combination of Abgrall with Butler is inappropriate. Abgrall teaches a system for managing BIOS data. Butler relates to a video overlay system. One of ordinary skill in the art would not think to combine the disparate elements of these references together. Rather, the Examiner has engaged in hindsight piece-meal reconstruction of the elements of claim 13.

Further, Nishio does not cure these defects of Butler and Abgrall. The Examiner has not indicated and Applicants have been unable to discern any part of Nishio that teaches a local directory structure wherein each directory is associated with a device as claimed in claim 13. Further, the Examiner has failed to provide any motivation for combining Nishio with Abgrall and Butler. Rather, the Examiner simply provides a statement that it would be obvious to one of ordinary skill in the art to combine elements of Nishio with Butler and Abgrall. See page 6, second full paragraph of the Office Action. See MPEP § 2143.01, "The Prior Art Must Suggest the Desirability of the Claimed Invention." Thus, the Examiner has failed to establish a *prima facie* case of obviousness for claim 13 based on Butler in view of Abgrall and Nishio. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 13 are requested.

In regard to claims 14-16, these claims depend from independent claim 13 and incorporate the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 13, these claims are not obvious over Butler, Abgrall and Nishio. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to claim 17, this claim, as amended, includes many of the same elements as independent claim 13 including a local directory structure that includes "a directory associated with a device." Thus, at least for the reasons mentioned above in regard to independent claim 13, Butler cannot be combined with Abgrall and Nishio to teach each of the elements of this claim. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 17 are requested.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Butler, Abgrall and Nishio and in further view of Jefferson.

Claim 18 depends from independent claim 17 and incorporates the limitations thereof. Thus, at least for the reasons mentioned above in regard to independent claim 17, Butler, Abgrall, and Nishio do not teach or suggest each of the elements of claim 18, namely, the local directory

• structure that includes the directory associated with the device. The Examiner has not indicated and Applicants have been unable to discern any part of Jefferson that teaches or suggests these elements of claim 18. Therefore, Jefferson does not cure the defects of Butler, Abgrall and Nishio. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 18 are requested.


### CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-5, 7-23 and 25-31 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207 3800.

Respectfully submitted,

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### CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Fee-Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 6, 2004.

  
Lillian E. Rodriguez

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